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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANURADHA NARASIMHASWAMY MELKOTE, DAMIAN  
POCARI, and KELLY ANNE SLANK

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Appeal 2009-010462  
Application 09/552,131  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU  
R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-41 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF THE DECISION

We AFFIRM.

## THE INVENTION

The Appellants' claimed invention is directed an on-line invention disclosure system (Spec. 1:1-3). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter of appeal.

1. A method of forming an invention disclosure comprises the steps of:
  - forming an invention disclosure online by entering a plurality of selected information portions into a web-based system;
  - after each of the plurality of selected information portions are entered, storing each of the information portions in a central storage location;
  - allowing access to various users comprising at least one inventor of said invention disclosure for reviewing the information; and
  - [1] allowing on-line access to the status of the invention disclosure, said status comprising where said invention disclosure is in a reviewing and application filing process.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Tran	US 2001/0049707 A1	Dec. 6, 2001
Tran	US 2002/0095368 A1	Jul. 18, 2002
Anecki	US 2006/0010377 A1	Jan. 12, 2006
Mathews	US 2006/0190443 A1	Aug. 24, 2006

The following rejections are before us for review:

1. Claims 1-20 and 22-41 are rejected under 35 U.S.C. § 103(a) as unpatentable over Tran ‘368, Anecki, and Tran ‘707.
2. Claim 21 is rejected under 35 U.S.C. § 103(a) as unpatentable over Tran ‘368, Anecki, Tran ‘707, and Mathews.

### THE ISSUES

The issue turns on whether it would have been obvious to combine the cited prior art to meet the argued claim limitations for each respective claim that has been argued.

### FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:<sup>1</sup>

FF1. Tran ‘707 has disclosed a method for the electronic patent filing of an application, or any other document related to the prosecution of the patent,

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

through an on-line communication in which the documents to be filed are checked for errors [0017].

FF2. Anecki has disclosed a method for interactively generating legal documents by a requestor for a recipient (Abstract). Anecki in Fig. 1 shows an Administrator 1040, Director A 1020, Director B 1030, Marketing Representative 1010, and Customer 100 with access to Legal Document Server materials.

FF3. Tran '368 had disclosed a system for trading intellectual property with a user interface to trade an IP asset (Abstract). The system supports purchasing or selling of intellectual property with a computerized bid, auction and sale system over the Internet [0006].

FF4. Matthews has disclosed a method for providing access to drawing information (Title).

## ANALYSIS

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper because Anecki does not show claim limitation [1] and also because the combination of the cited references would not have been obvious (Br. 4-5, 7-8).

In contrast, the Examiner has determined that the prior art discloses the cited claim limitation [1] and that the combination of the cited references would have been obvious (Ans. 4-7, 27-28).

We agree with the Examiner. Tran '707 has disclosed a method for the electronic patent filing of an application, or any other document related to the prosecution of the patent, through an on-line communication in which the documents to be filed are checked for errors (FF1). Anecki has disclosed

a method for interactively generating legal documents by a requestor for a recipient and shows that various administrators and the customer can access legal documents in the system (FF2). Tran '368 has disclosed a system for trading intellectual property in an auction and sale system over the Internet (FF3).

The modification of the electronic patent filing method of Tran '707 to include access to the legal documents for the parties involved in the system and for trading of the intellectual property in an online auction as taught by Anecki and Tran '368 would have been an obvious, predictable combination of familiar elements for the advantage of having an electronic patent filing method in which relevant parties could access the legal patent documents and trade the IP assets if desired to raise funds. The cited modification of Tran '707, Anekci, and Tran '368 would meet claim limitation [1] by providing an online patent filing system in which parties could access the legal documents and check on the status of the application. For this reason, the rejection of claim 1 is sustained.

With regards to claims 3, 4, 17, 23, and 37, these claims recite various limitations drawn to prompting inventors for approval, prompting the user for classification information and notifying the evaluator in response to the classification information, selecting the evaluator based on the classification information, and performing a search to the state of art. In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) the Court stated that when considering obviousness that "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR* at 418. Here, the argued claimed functions

from claims 3-4, 17, 23, and 37 are basic functions in the submission and evaluation of a patent application and one of ordinary skill in the art would readily have inferred that these functions could be incorporated into such an online patent filing combined system if desired for the advantage of automating the process. For these reasons the rejection of claims 3-4, 17, 23, and 37 is sustained as well. The Appellants have not argued the remaining claims separately and the rejection of these claims is sustained for the same reasons given above.

#### DECISION

The Examiner's rejection of claims 1-41 is sustained.

#### AFFIRMED

MP